REMARKS

Claims 1-7, 27-31 are pending in the present application.

Claim Rejections - 35 USC § 103

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. (US 2003/0072923) in view of Omatsu et al. (EP 1 251 154).

Sumioka is cited as teaching an ink jet recording material comprising a support and an ink receptive layer on the support. The Office correctly acknowledges that Sumioka fails to recite the claimed non-polymeric compound recited in current claim 1 as the additive.

Omatsu is cited as teaching an ink jet composition comprising a compound of formula I and a suitable example with reference to compound (I-73).

Sumioka is specific to an ink-jet recording material as is the instant application. Omatsu is specific to an ink. The Office has considered it obvious to utilize a material from an ink in an ink-jet recording material based on the argument that both references are in the filed of ink jet recording medium art. Applicants respectfully disagree with this assessment.

Omatsu describes the purpose of the additives. As specifically stated in paragraph [0010] the object is to provide an ink composition having high discharge stability after storage, which is free from defects in color hue, has shelf life stability, water resistance and high image quality. All of these properties are properties of the ink irregardless of the media. These properties are necessary even if the ink is never applied to a media.

The Office has considered it to be obvious to take a material from the ink and insert it into the media in spite of the fact that none of the expected benefits are relavent in media and many of them are impossible to contemplate much less measure. One of skill in the art has no concern with high discharge stability after storage for media. Media is never discharged from a printer jet. One of skill in the art has concern about color hue for the media but this is taken care of by pigments and additives in a transparent base not fading of a dye. Shelf life for media is a concern but not as related to discharge properties such as viscosity, precipitation and the like as it is for ink.

The Office has considered it obvious to take a material from one component which solves a particular problem and utilized this material in a radically different component which does not even have those problems which the additive is designed to solve.

As a courtesy the Office has recited the Supreme Court decision in KSR and then ignored the teachings therein with regards to predictable results. If one did attempt to predict the results of the combination they could only anticipate improved discharge, aging, and other properties which are meaningless when referring to a media. Applicants respectfully submit that one of skill in the art would have no basis for considering the present combination of art except by hindsight reconstruction which is still impermissible when the combination is not additive, not predictable and selected in hindsight to solve a problem which does not exist.

With reference to compound (I-73) of Omatsu the Office has erred in describing the chemical formula. Compound (I-73) is not within the scope of formula I of instant claim 1.

Claims 2-6 ultimately depend from claim 1 and are therefore patentable for, at least, the same reasons as claim 1.

The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. (US 2003/0072923) in view of Omatsu et al. (EP 1 251 154) is improperly based on a hindsight reconstruction which one of skill in the art would have no basis for considering since the components chosen are specifically taught to solve a problem which does not exist. The rejection is improper and traversed.

Claims 7 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. in view of Omatsu et al.

Sumioka is cited as teaching an ink jet recording material comprising a support and an ink receptive layer on the support. The Office correctly acknowledges that Sumioka fails to recite the claimed non-polymeric compound recited in current claim 1 as the additive.

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concern about color hue for the media but this is taken care of by pigments and additives in a transparent base not fading of a dye. Shelf life for media is a concern but not as related to discharge properties such as viscosity, precipitation and the like as it is with ink.

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As a courtesy the Office has recited the Supreme Court decision in KSR and then ignored the teachings therein with regards to predictable results. If one did attempt to predict the results of the combination they could only anticipate improved discharge, aging, and other properties which are meaningless when referring to a media. Applicants respectfully submit that one of skill in the art would have no basis for considering the present combination of art except by hindsight reconstruction which is still impermissible when the combination is not additive, not predictable and selected in hindsight to solve a problem which does not exist.

With reference to compound (I-73) of Omatsu the Office has erred in describing the chemical formula. Compound (I-73) is not within the scope of formula I of instant claim 7.

Claims 27-31 ultimately depend from claim 7 and are therefore patentable for, at least, the same reasons as claim 7.

The rejection of claims 7 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. (US 2003/0072923) in view of Omatsu et al. (EP 1 251 154) is improperly based on a hindsight reconstruction which one of skill in the art would have no basis for considering since the components chosen are specifically taught to solve a problem which does not exist. The rejection is improper and traversed.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. in view of Wong et al. (US 6,319,310).

Sumioka is discussed above and all previous comments are equally applicable herein. In summary, Sumioka is specific to an ink jet recording material. The Office has correctly acknowledged that Sumioka fails to recite the claimed non-

polymeric compound as an additive. Wong is recited as teaching an ink jet composition comprising a carbamate.

Wong describes, throughout the specification, that the purpose of the carbamates is to improve the acoustic loss value of a hot melt acoustic ink when employed in a suitable ink jet printing process. The Office has considered it obvious to utilize the carbamates of Wong in the material of Sumioka to improve the quality, lightfastness and water fasteness with minimal feathering.

With regards to improving quality the Office has not considered the quality parameters which the carbamate improves. One of skill in the art would have no motivation to improve the acoustic loss value of an ink receptive material. Acoustic loss is a property of the ink within the print head.

Light-fastness, water-fastness and feathering are properties of the ink. There is no predictable equivalent property associated with the ink receptor.

The combination of Sumioka and Wong is based on an impermissible hindsight reconstruction wherein a component is added to a material based on expectations of improvements in

properties which do not exist. A rejection of claim 1 based on such a combination is improper.

Claims 2-6 ultimately depend from claim 1 and are patentable for, at least, the same reasons as claim 1.

The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. in view of Wong et al. (US 6,319,310) is improper and traversed.

Claims 7 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. in view of Wong et al.

Sumioka is discussed above and all previous comments are equally applicable herein. In summary, Sumioka is specific to an ink jet recording material. The Office has correctly acknowledged that Sumioka fails to recite the claimed non-polymeric compound as an additive. Wong is recited as teaching an ink jet composition comprising a carbamate.

Wong describes, throughout the specification, that the purpose of the carbamates is to improve the acoustic loss value of a hot melt acoustic ink when employed in a suitable ink jet

printing process. The Office has considered it obvious to utilize the carbamates of Wong in the material of Sumioka to improve the quality, lightfastness and water fasteness with minimal feathering.

With regards to improving quality the Office has not considered the quality parameters which the carbamate improves. One of skill in the art would have no motivation to improve the acoustic loss value of an ink receptive material. Acoustic loss is a property of the ink within the print head.

Light-fastness, water-fastness and feathering are properties of the ink. There is no predictable equivalent property associated with the ink receptor.

The combination of Sumioka and Wong is based on an impermissible hindsight reconstruction wherein a component is added to a material based on expectations of improvements in properties which do not exist. A rejection of claim 7 based on such a combination is improper.

Claims 27-31 ultimately depend from claim 7 and are patentable for, at least, the same reasons as claim 7.

The rejection of claims 7 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Sumioka et al. in view of Wong et al. is improper and traversed.

CONCLUSIONS

Claims 1-7, 27-31 are pending in the present application. All claims are believed to be in condition for allowance. Notice thereof is respectfully requested.

Respectfully submitted,

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Joseph T. Guy, Ph.D.
Agent for Applicants
Registration Number 35,172
Customer No.: 46591